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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,745	02/11/2002	Peter G. Schultz	220032001301	2759

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MADELINE JOHNSTON , ESQ
KING & SPALDING LLP
191 PEACHTREE STREET
ATLANTA, GA 30303-1763

EXAMINER	
SHIBUYA, MARK LANCE	
ART UNIT	**PAPER NUMBER**
1639	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,745	SCHULTZ ET AL.	
	Examiner	Art Unit	
	Mark L. Shibuya	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *94,96-121,124 and 127-170* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *94,96-121,124 and 127-170* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/3/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 94, 96-121, 124, 127-170 are pending and examined herein.

Withdrawn Rejections

2. The rejection of claims 163-165 under 35 U.S.C. 112, first paragraph, for new matter, is withdrawn in view of applicant's arguments, filed 11/3/2004.

3. The rejection of claims 94, 96-103, 106, 107, 112, 115, 116, 121, 124, 129-145, 151, 152, 158, and 163-165 under 35 U.S.C. 112, first paragraph, for not enabling one of skill in the art to make and use the invention commensurate in scope with the claims, is withdrawn in view of applicant's arguments, filed 11/3/2004.

Withdrawn Objections

4. The objection to claims 166-170 as being in improper form, as set forth in the previous Office action, mailed 5/4/2004, is withdrawn in view of applicant's amendments to the claims. Claims 166-170 are examined herein.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/03/2004 has been entered.

Election/Restrictions

5. The Requirement for election restriction (Requirement for Restriction/Election mailed 7/30/2002 and 11/18/2002) and elected by applicant (1/21/2003) is continued from the previous office action (4/9/2003). In accordance with the requirement for election of species, and because the claims are free of the prior art, all species and the claims thereof are rejoined and examined herein.

Priority

6. The instant application is a continuation of 09/127,195, filed 7/31/1998, now US Patent 6,346,290, which is a divisional of 08/327,513, filed 10/18/1994, now US Patent 5,985,356.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 94, 96-121, 124, 127-170 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 6,004,617. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing components or monomers to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over the methods of making at least two different arrays of material comprising delivering components and reacting the components to form at least two different materials of apparently commonly assigned U.S. Patent No. 6,004,617, by a different inventive entity.

8. Claims 94, 96-121, 124, 127-170 are directed to an invention not patentably distinct from claims 1-61 of commonly assigned 6,004,617. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon components or monomers, to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over the methods of making at least two different arrays of material comprising delivering components and reacting the components to form at least two different materials of apparently commonly assigned U.S. Patent No. 6,004,617, by a different inventive entity.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 6,004,617, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting

inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

9. Claims 94, 96-121, 124, 127-170 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,346,290. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon components or monomers to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over the methods of evaluating and preparing an array of polymeric material by delivering components and an initiator to and polymerizing said components on a substrate to form non-biological organic polymers and screening the said polymers of apparently commonly assigned U.S. Patent No. 6,346,290, by a different inventive entity.

10. Claims 94, 96-121, 124, 127-170 are directed to an invention not patentably distinct from claims 1-52 of commonly assigned U.S. Patent No. 6,346,290. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon components or monomers, to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over the methods of evaluating and preparing an array of polymeric material by delivering components and an initiator to a substrate, and polymerizing said components on the substrate to form non-biological organic polymers and screening the said polymers of U.S. Patent No. 6,346,290.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 6,346,290, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

11. Claims 94, 96-121, 124, 127-170 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,794,052. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon components or monomers, to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over the arrays comprised of more than 10 different polymeric materials in regions on a substrate, each polymeric material being a non-biological, organic polymer not synthesized by a linear, stepwise coupling of building blocks, said polymeric materials being situated on or in hydrophilic regions and the area on said substrate outside of said regions being hydrophobic, and with said regions being situated on said substrate so that said polymeric materials cannot move between adjacent regions of apparently commonly assigned U.S. Patent No. 6,794,052, by a different inventive entity.

12. Claims 94, 96-121, 124, 127-170 are directed to an invention not patentably distinct from claims 1-13 of commonly assigned U.S. Patent No. 6,794,052. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon

components or monomers, to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over the arrays comprised of more than 10 different polymeric materials in regions on a substrate, each polymeric material being a non-biological, organic polymer not synthesized by a linear, stepwise coupling of building blocks, said polymeric materials being situated on or in hydrophilic regions and the area on said substrate outside of said regions being hydrophobic, and with said regions being situated on said substrate so that said polymeric materials cannot move between adjacent regions of apparently commonly assigned U.S. Patent No. 6,794,052, by a different inventive entity.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 6,794,052, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

13. Claims 94, 96-121, 124, 127-170 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-93 of copending Application No. 09/881,036. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon components or monomers, to form one or more or ten or more non-biological organic polymers of the instant application, are obvious over methods of making and screening arrays of materials comprising delivering components and simultaneously reacting said components to form at least two materials, and the materials made thereby, of apparently commonly assigned copending Application No. 09/881,036, by a different inventive entity.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 94, 96-121, 124, 127-170 are directed to an invention not patentably distinct from claims 1-93 of commonly assigned copending Application No. 09/881,036. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the methods for preparing and evaluating an array of polymeric materials comprising delivering to a substrate and polymerizing thereon components or monomers, to form one or more or ten or more non-biological organic

polymers of the instant application, are obvious over methods of making and screening arrays of materials comprising delivering components and simultaneously reacting said components to form at least two materials, and the materials made thereby, of apparently commonly assigned copending Application No. 09/881,036, by a different inventive entity.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned copending Application No. 09/881,036, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

15. Claims 98, 99, 130 and 133 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 98 recites the limitation "said single substrate" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 99 recites the limitation " said single substrate " in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 130 recites the limitation "the delivered first and second components" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 133 recites the limitation "the reaction solvents" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Conclusion

16. All claims are rejected.

17. Claims 94, 96-121, 124, 127-170 are free of the prior art. The closest prior art is that of Clark et al., US Patent No. 4,728,591, which teaches non-biological arrays of one or more polymers, but does not teach polymerization of components upon a substrate, (as in the claimed invention), but rather the adsorption of polymers upon a substrate.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark L. Shibuya
Examiner
Art Unit 1639

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